

Notice of Allowability

Application No.

10/617,431

Applicant(s)

ZHANG ET AL.

Examiner

Art Unit

Robert Shiao

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 08/24, 2005.
2. ☒ The allowed claim(s) is/are 73-75, 77-81, 83-89, and 121-128, now are 1-23.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

1. This application claims benefit of the provisional application: 60/395,067 with a filing date 07/11/2002.
2. Amendment of claims 73-75, 84-85, cancellation of claims 20-72, 76, 82, 90-117, addition of claims 121-128, and a filed declaration under 37 CFR 1.131 in the amendment filed on August 24, 2005, is acknowledged. Claims 1-19, 73-75, 77-81, 83-89, and 118-128 are pending in the application. No new matter is found. Since the newly added claims 121-128 are commensurate with the scope of the invention, therefore, claims 1-19, 73-75, 77-81, 83-89, and 118-128 are prosecuted in the case.

Responses to Amendment and Arguments

3. Applicant's arguments regarding rejection of claims 73-75, 77-81, 83-89 under 35 U.S.C. 112, first paragraph, filed on August 24, 2005, have been fully considered and they are persuasive. The limitation of "fluorous group", "nucleophilic group", "leaving group", or "electrophilic group" has been found on pages 13-14 of the specification. Therefore, rejection of claims 73-75, 77-81, 83-89 under 35 U.S.C. 112, first paragraph, is withdrawn herein. Since claims 76 and 82 have been cancelled, therefore, rejection of claims 76 and 82 is obviated herein.
4. In claim 73, since both variables R^1 and R^2 do not represent hydrogen when the variable X represents a leaving group, nucleophilic group or electrophilic group (i.e., -OH), therefore rejection of claims 73-75, 77-81, 83-89 under 35 U.S.C. 102(a) or 103(a) over Onishi et al. US 6,600,074 or Curran et al. US 6,749,756, has been

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overcome in the amendment filed on August 24, 2005. Since claims 76 and 82 have been cancelled, therefore, rejection of claims 76 and 82 under 35 U.S.C. 102(a) or 103(a) is obviated herein.

5. Applicant's arguments regarding rejection of 73-75, 77-81, 83-89 under 35 U.S.C. 102(a) over Schwinn et al. compound No. 12, filed on August 24, 2005, have been fully considered but they are not persuasive, because the invention of filed declaration under 37 CFR 1.131 is not related to the compound of Schwinn et al. It is noted that Schwinn et al. compound (i.e., compound No. 12) comprises a phenyl moiety substituted with a fluororous group having a silicon atom, while the declared invention compounds comprise a phenyl moiety substituted with a fluororous group without a silicon atom. Therefore, the declaration is ineffective to overcome Schwinn et al. reference, rejection of 73-75, 77-81, 83-89 under 35 U.S.C. 102(a) over Schwinn et al. is maintained.

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with Joseph L. Kent on October 20, 2005. The application has been amended as follows:

In claim 73, line 11, after "N-imidazolyl", insert

--, -OC(O)-Cl--

In claim 73, line 20, after "electrophilic group, X", delete "comprises", and insert

--is--

Delete claims **1-19** and **118-120**

Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

Claims 73-75, 77-81, 83-89 and 121-128 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to new fluororous tagging and scavenging reactants and methods of synthesis and use thereof. The closest reference is Onishi et al. US 6,600,074, discloses perfluoroalkylated aniline compound and process for producing the same. The difference between Onishi et al. and instant claims is that the instant claimed compounds are not found in Onishi et al. Suggestion for modification of above record to obtain the instant claimed compounds has not been found. Claims 73-75, 77-81, 83-89 and 121-128 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusions

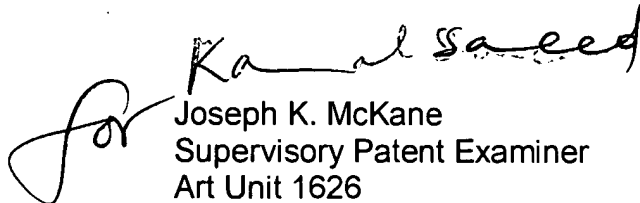
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert Shiao, Ph.D.
Patent Examiner
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Joseph K. McKane
Supervisory Patent Examiner
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October 20, 2005